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| 70813 7590 01/26/2009 GOODWIN PROCTER LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001 | | | | |
| EXAMINER CARTER, CANDICE D | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/830,114

Applicant(s)

BRENNER ET AL.

Examiner

CANDICE D. CARTER

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Following is a Final Office Action in response to communications received on November 20, 2008. Claims 1-3, 9, 16-18, 24, and 31-33 have been amended. No claims have been cancelled. No new claims have been added. Therefore, claims 1-33 are pending and have been addressed below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-15 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-15 and 33 are directed towards a computer implemented method for management and delivery of content and rules, comprising, managing data, packaging data, delivering data, integrating data, and distributing data.

Examiner contends that a process must be (1) tied a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

An applicant may show that a process claim satisfies 35 U.S.C. § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the

machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. *In re Bilski*.

In the instant case, the recitation of a computer in the preamble of the claims is merely insignificant extra-solution activity and, thus, does not qualify as a statutory the invention as a process.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-6, 9-21, and 29-32 rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. (2002/0095481, hereinafter George) in view of LeMole et al. (6,009,410, hereinafter LeMole) and further in view of Quatse et al. (2005/0010472, hereinafter Quatse).**

As per claim 16, George discloses "A system for management and delivery of content and rules, the system comprising:

at least one first database entity that manages a plurality of data" (Fig. 1 discloses a customer database managing customer information);

"at least one second database entity that manages a plurality of content, wherein the plurality of content is associated with the plurality of data based on a plurality of rules" (Fig. 1 discloses a content database and ¶ 8 discloses that the content database

contains product data sets that are associated with the customers and ¶ 23 discloses associating the product data sets with the customer data using a set of business rules);

“a processor module” (Fig. 1 discloses an email content merge program that serves as a processor module);

“a delivery module” (Fig.1 discloses an email delivery server);

“and one or more presentation channels” (Fig. 1 discloses an email delivery server that serves as a presentation channel, where the electronic communication is used as a presentation channel);

“where the processor module packages the plurality of rules with the plurality of content in a carrier that is independent from the one or more presentation channels, wherein at least part of the plurality of content is integrated with at least part of the plurality of data” (¶ 19 discloses the email content merge program selecting a product data set as a function of the information contained in the customer database and business rules as disclosed in ¶ 23 so that a message can be constructed, where it is inherent that a carrier is used to package and transport information);

“the delivery module delivers the plurality of data and the carrier to the one or more presentation channels” (¶ 19 discloses constructing and sending a communications message such as an email);

“and the one or more presentation channels integrate the plurality of data with the plurality of content based on the plurality of rules, and distribute the integrated data and content” (¶ 19 discloses constructing and sending a communications message such

as an email and ¶ 23 discloses associating the product data sets with the customer data using a set of business rules).

George, however, fails to explicitly disclose "the plurality of rules controlling a logical combination and physical layout of the plurality of data and plurality of content"; "logically integrate the data and content and control the physical layout of the integrated data"; and "multiple presentation channels".

LeMole discloses a method and system for presenting customized advertising to a user on the World Wide Web having a plurality of rules controlling a logical combination and physical layout of the plurality of data and logically integrating the data and content and controlling the physical layout of the integrated data and content (col. 7, line 36-55 discloses providing to the user information elements that are composited, arranged and presented specifically for the user based on some predetermined information, where the predetermined information are rules, where compositing is integrating, and where arranging is arranging the physical layout of the content).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system for customizing electronic communications of George to include the integration of data and content and the controlling of the physical layout of the data and content as taught by LeMole since such would increase the probably of presenting information that is of particular interest to the particular user.

Quatse discloses high-precision customer-based targeting having multiple presentation channels (§ 36 discloses multiple presentations such as email, cellular, telephones, PDAs, Internet, direct mail, voice phone, and others).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system for customizing electronic communication of George to include the multiple presentations as taught by Quatse since such would provide multiple avenues to distribute content.

Claims 1, 31, and 32 recite equivalent limitations to claim 16 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 2, George discloses "the plurality of data is associated with a plurality of products and a plurality of clients" (§ 19 discloses a customer profile/behavioral data stored in a database that is associated with product data sets from a content database).

Claim 17 recites equivalent limitations to claim 2 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 3, George discloses "the plurality of data and the plurality of content is associated with financial products" (§ 19 discloses the content database managing product data sets).

Examiner considers financial products to be nonfunctional descriptive material as recited. The type of product that the content is associated with does not change the function of the claimed invention. Examiner contends that the content database of George is fully capable of managing any type of product data.

Claim 18 recites equivalent limitations to claim 3 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 4, the George, LeMole and Quatse combination discloses all of the elements of the claimed invention but fails to explicitly disclose "the carrier comprises a plurality of style tags, wherein the plurality of style tags are associated with the plurality of content based on a plurality of rules".

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system for customizing electronic communications of George to include style tags associated with the plurality of content based on a plurality of rules because "they are known to those skilled in the art as features present in various types of files such as HTML files in order to define style rules within a documents HTML tag" through Applicant's admission provided on pgs. 15-16 of arguments.

Claim 19 recites equivalent limitations to claim 4 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 5, George discloses all of the elements of the claimed invention but fails to explicitly disclose "the plurality of content comprises a graphic element".

LeMole discloses a method and system for presenting customized advertising to a user on the World Wide Web presenting graphic element content (abstract discloses 3D images, animation, and video).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of customizing

electronic communications of George to include the graphic element content as taught by LeMole in order to sufficiently present the content to the user in a format that is easily understood.

Claim 20 recites equivalent limitations to claim 5 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 6, George discloses all of the elements of the claimed invention but fails to explicitly disclose "the plurality of content is stored in at least one media-independent format".

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the content stored in media-independent format because it is old and well known to store information in different formats that may be compatible with different systems.

Claim 21 recites equivalent limitations to claim 6 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 9, George discloses all of the elements of the claimed invention but fails to explicitly disclose "the integration of plurality of data with the plurality of content is further based on the specific needs of the one or more presentation channels".

Quatse discloses high-precision customer-based targeting integrating the data based on the specific needs of the one or more presentation channels (§ 36 discloses promotional offers are presented by distributing offers through the channels in formats particular to the channel).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the integration of data based on the needs of the presentation channel as taught by Quatse in order to facilitate the use of the different presentation channels.

Claim 24 recites equivalent limitations to claim 9 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 10, George discloses all of the elements of the claimed invention but fails to explicitly disclose "sharing the plurality of data and the plurality of content among a plurality of business lines".

Quatse discloses high-precision customer-based targeting sharing the plurality of data and the plurality of content among the plurality of business lines (§ 48 discloses segmenting customers into market segments, where customer and product data are shared among market segments and where examiner construes market segments to be business lines).

As per claim 11, George discloses all of the elements of the claimed invention but fails to explicitly disclose "editing the plurality of content and the plurality of business rules via a user interface".

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the editing of content and business rules via a user interface because it is old and well known to edit information that is used for

business operations and to edit information using an interface such as a keyboard in order to ensure that the information is accurate and up to date.

Claim 26 recites equivalent limitations to claim 11 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 12, George discloses all of the elements of the claimed invention but fails to explicitly disclose "comprising previewing at least one combination of the plurality of data and the plurality of content for legal compliance".

Quatse discloses laws penalizing a telemarketer who calls a telephone that is registered on a "do not call" list (§ 12).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the penalty for calling those telephone numbers that are on the "do not call list" in order to deter telemarketing companies from violating the list.

The George, LeMole, and Quatse combination fails to explicitly disclose "previewing the plurality of data and content for legal compliance.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of the George, LeMole, and Quatse combination to include previewing content for legal compliance because it is old and well known to monitor business operations to ensure that all practices comply with the law.

Claim 27 recites equivalent limitations to claim 12 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 13, the George, LeMole, and Quatse combination discloses all of the elements of the claimed invention but fails to explicitly disclose "auditing the integrated data and content prior to the step of distributing".

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of the George, LeMole, and Quatse combination to include auditing the data before distributing the content because it is old and well known to review documents or content in order to make sure that they are in compliance with company policy.

Claim 28 recites equivalent limitations to claim 13 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 14, George discloses all of the elements of the claimed invention but fails to explicitly disclose "automatically generating at least one layout file for distribution".

Quatse discloses high-precision customer-based targeting generating at least one layout file for distribution (§ 63 discloses offer distribution lists).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of George to include the distribution list as taught by Quatse in order to distribute the promotional offers to customers.

Claim 29 recites equivalent limitations to claim 14 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 15, George discloses "the one or more presentation channels comprises an electronic communication" (Fig. 1 and ¶ 19 discloses an email message)

Claim 30 recites equivalent limitations to claim 15 and is, therefore, rejected using the same art and rationale as set forth above.

6. Claims 7, 8, 22, 23, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over George in view of LeMole in view of Quatse and further in view of Todd et al. (20030061057, hereinafter Todd).

As per claims 7 and 8, the George, LeMole, and Quatse combination discloses all of the elements of the claimed invention but fails to explicitly disclose "the plurality of content is packaged based on an extensible markup language" and "the plurality of rules are packages based on an XSL transformations language".

Todd discloses a storage service registration application using XML and XSL (¶ 82 discloses XSL as a rule based language for transforming XML).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system for customizing electronic communications of the George, LeMole, and Quatse combination to include the XML and XSL as taught by Todd since such would facilitate transforming the content into a composite presentation of data.

Claims 22 and 23 recite equivalent limitations to claims 7 and 8 and are rejected using the same art and rationale as set forth above.

As per claim 33 George discloses "A method for management and delivery of content and rules, the method comprising:

managing, for an organization, a plurality of data and a plurality of content in separate database entities, wherein the plurality of data are associated with a plurality of products and a plurality of clients, and the plurality of content is associated with the plurality of data based on a plurality of rules" (¶ 8 discloses a customer database and a content database and ¶ 23 discloses associating content and customer data based on business rules);

"packaging the plurality of rules with the plurality of content in a carrier that is independent from one or more presentation channels, wherein at least part of the plurality of content is integrated with at least part of the plurality of data" (¶ 19 discloses an email content merge program, merging the content and customer data together, where it is inherent that the information is transported using a carrier),

"delivering the plurality of data and the carrier to the one or more presentation channels, wherein the one or more presentation channels comprise at least one of an Internet website, a printed communication, an electronic communication, a printed advertisement, a broadcast advertisement, a telemarketing script, an interactive voice response unit message, an automatic teller machine (ATM) message, and a display-board message" (¶ 19 discloses constructing and sending a communications message such as an email);

"integrating, at the one or more presentation channels, the plurality of data with the plurality of content based on the plurality of rules and distributing the integrated data

and content through the one or more presentation channels" (§ 19 discloses an email content merge program, merging the content and customer data together and emailing the content to the customer).

George, however, fails to explicitly disclose "the plurality of content is stored in at least one media-independent format and comprises at least one of a discrete text element, a compiled text element and a graphic element, the plurality of content is packaged based on an extensible markup language (XML), and the plurality of rules are packaged based on an XSL transformations (XSLT) language; and the content is packaged based on the specific needs of the one or more presentation channels";

LeMole discloses a method and system for presenting customized advertising to a user on the World Wide Web presenting graphic element content (abstract discloses 3D images, animation, and video).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system of customizing electronic communications of George to include the graphic element content as taught by LeMole in order to sufficiently present the content to the user in a format that is easily understood.

The George and LeMole combination fails to explicitly disclose that the content is packaged based on the specific needs of multiple presentation channels.

Quatse discloses high-precision customer-based targeting integrating the data based on the specific needs of the one or more presentation channels (§ 36 discloses

promotional offers are presented by distributing offers through the multiple channels in formats particular to the channel).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for customizing electronic communications of the George and LeMole combination to include the integration of data based on the needs of the presentation channel as taught by Quatse in order to facilitate the use of the different presentation channels.

The George, LeMole, and Quatse combination discloses all of the elements of the claimed invention but fails to explicitly disclose "the plurality of content is packages based on an extensible markup language" and "the plurality of rules are packages based on an XSL transformations language.

Todd discloses a storage service registration application using XML and XSL (§ 82 discloses XSL as a rule based language for transforming XML).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the system for customizing electronic communications of the George, LeMole, and Quatse combination to include the XML and XSL as taught by Todd since such would facilitate transforming the content into a composite presentation of data.

Response to Arguments

7. Applicant's arguments, see pg. 12-14, with respect to the 35 U.S.C. 101 rejections have been fully considered and are persuasive. The previous 35 U.S.C. 101 rejection of claims 1-33, as applied in the previous Office Action has been withdrawn.

Applicant's arguments, see pg. 15-16, with respect to the 35 U.S.C. 112, second paragraph rejection have been fully considered and are persuasive. The previous 35 U.S.C. 112, second paragraph rejections of claims 1-33, as applied in the previous Office Action have been withdrawn.

Applicant's arguments with respect to claims 1, 4, 7-9, 16, 22, 23, 31, 32, and 33 have been considered but are moot in view of the new ground(s) of rejection.

In response to arguments for claim 6 and 21 with respect to the traversal of the "Official Notice", Examiner notes that there was merely an assertion that such recited limitations are old and well known in the pertinent art and that no actual Official Notice has been taken with respect to these claims. Furthermore, Applicant has failed to particularly point out why the recited limitations are not old and well known in the art. Because of the lack of sufficient reply, Examiner maintains the rejection.

In response to arguments in reference to claims 2, 3, 5, 10-15, 17-20, 24-28, and 30, all rejections made towards the dependent claims are maintained due to a lack of reply by the applicant in regards to distinctly and specifically pointing out the supposed errors in the examiner's prior office action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and patentable over the prior art.

Examiner notes that claim 29 was treated on the merits in the prior Office Action on page 10.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Damico et al. (5,819,285) discloses an apparatus for capturing, storing and processing co-marketing information associated with a user of an on-line computer service. Deaton et al (5,675,662) discloses a method and system for building a database for user with selective marketing in response to customer shopping histories. Hedgecock et al. (6,182,060) discloses a method and apparatus for storing retrieving and processing multi-dimensional customer-oriented data sets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday thru Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. C./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629